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EXAMINER	
WANG, JIN CHENG	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/775,710	AGRAWALA ET AL.	
	Examiner	Art Unit	
	Jin-Cheng Wang	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments

Applicant's submission filed on 3/26/2007 has been entered. Claims 1-5, 7-10, 13-14, and 20 have been amended. Claims 1-20 are pending in the application.

Response to Arguments

Applicant's arguments dated 3/26/2007 with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection based on Price et al. US Patent Application Publication 2001/0043716 (hereinafter Price).

Price discloses a system that facilitates free form digital inking (e.g., Figs. 2-6), the system is recorded on a computer-readable medium and capable of execution by a computer, comprising:

An annotation management component (Figs. 1, 6A-6B and 7-9 and Paragraph 0044-0046) that generates an inking region for a digital document (See Figs. 2A-2B and 3A-3B wherein at least an inking region in Fig. 3B is generated and zoomed; see also Paragraph 0033 for zooming/scaling of the inking region); and

A navigation component (Figs. 1, 6A-6B and 7-9; Paragraph 0044-0046) that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document (*Replaying the data trace or portions of the data trace that correspond to freeform digital ink annotations as the user annotates the digital document means that the portions of the data trace that correspond to*

freeform digital ink annotations are displayed prior to, concurrently with and after a user annotates the digital document. This is because the portions or the enlarged portions in Figs. 2B or 3B are displayed before the user's new annotation, during the user's new annotation and after the user's new annotation).

Applicant's arguments dated 3/26/2007 with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection based on Marshall et al. U.S. Patent Application Publication 2003/0070139 (hereinafter Marshall).

Marshall discloses a system that facilitates free form digital inking (e.g., Figs. 2-6), the system is recorded on a computer-readable medium and capable of execution by a computer, comprising:

An annotation management component (Figs. 7-10) that generates an inking region for a digital document (See Figs. 2-6 wherein at least an inking region is generated and zoomed); and

A navigation component (Figs. 7-10) that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document (*The user annotates the document to produce annotations such as the high-value annotations associated with the asterisk icons 510, 520 and 530 and the size and shape of the inking region dynamically depend upon the annotations highlighted/encircled/underlined by the emphasis determination circuit or routine while the user annotates the digital document; see Paragraph 0065 and 0074 for the annotation types including highlighting, encircling and underlining by the ink strokes over the annotated document. See Fig. 6 and Paragraph 0055 for the inking region wherein the inking region is stored in a memory and*

is displayed by a call-up 540 associated with the annotation associated with the asterisk 530 in an expanded view while maintaining the reader's orientation of the document 500. It is noted that the size of shape of the call-up associated with other annotations are dynamically dependent on the size and shape of the portions or passages of the document that have been annotated with the annotations, e.g., the annotations associated with the asterisk icon 510 and the asterisk icon 520).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-20:

Claim 1 applies a computer program in the form of a seemingly patentable apparatus or system as the claim 1 recites the system is recorded on a computer-readable medium and capable of execution by a computer, however, claim 1 in reality seeks patent protection for the computer program. Computer program per se is neither computer components nor statutory process. Thus, claim 1 is non-statutory.

Additionally, since claim 1 includes a 101 judicial exception, claim 1 must be for a practical application of the judicial exception. As is, claim 1 failed to recite either a physical transformation or produces a useful and tangible result. Thus, claim 1 is also non-statutory for this reason.

Claims 1-13 and 20 are non-statutory for the same reasons discussed above.

Claims 14-19 are the parallel method claims and are non-statutory for the same reasons discussed above.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For example, applicant speculates the claim limitation "manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document". In a non-limiting example at Page 20 of applicant's specification, the user

taps at the zoom origin and a zoom window is generated wherein the zoom window can be variously shaped and positioned, depending on the properties utilized during generation. This passage show a fixed zoom window. Moreover, applicant's specification at Page 20 stated that the document information displayed within the zoom window is scaled upon to allow the user to comfortably add annotations similar in size to the document information. This passage shows that the size of the zoom window corresponds to the document information which is fixed after the annotation was made. The claims 2-20 are subject to the same rationale of rejection set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Price et al. US Patent Application Publication 2001/0043716 (hereinafter Price).

Re Claims 1, 14 and 20:

Price discloses a system that facilitates free form digital inking (e.g., Figs. 2-6), the system is recorded on a computer-readable medium and capable of execution by a computer, comprising:

An annotation management component (Figs. 1, 6A-6B and 7-9 and Paragraph 0044-0046) that generates an inking region for a digital document (See Figs. 2A-2B and 3A-3B wherein at least an inking region in Fig. 3B is generated and zoomed; see also Paragraph 0033 for zooming/scaling of the inking region); and

A navigation component (Figs. 1, 6A-6B and 7-9; Paragraph 0044-0046) that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document (*Replaying the data trace or portions of the data trace that correspond to freeform digital ink annotations as the user annotates the digital document means that the portions of the data trace that correspond to freeform digital ink annotations are displayed prior to, concurrently with and after a user annotates the digital document. This is because the portions or the enlarged portions in Figs. 2B or 3B are displayed before the user's new annotation, during the user's new annotation and after the user's new annotation*).

Claim 2:

The claim 2 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the annotation management component is invoked to generate the inking region by identifying a point of interest on the digital document by at least one of a manual and an automatic technique. However, Price further discloses the claim limitation that the annotation management component is invoked to generate the inking region by identifying a point of interest on the digital document by at least one of a manual and an automatic technique (*See Paragraph 0032, 0034-0035 and Figs. 2A-2B and 3A-3B wherein the user annotates the*

digital document by at least one of a manual and an automatic technique to enable rendering of new data on a trace, recording of a freeform digital ink annotation on an automatic trace, rendering of freeform digital ink annotations on automatic traces, viewing a portion of an automatic trace that corresponds to some or all of the freeform digital ink annotations at a user's request and managing the storage of the data trace based upon freeform digital ink annotations).

Claim 4:

The claim 4 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the inking region is generated to cover a subset of the digital document such that the remaining document can be concurrently viewed.

However, Price further discloses the claim limitation that the inking region is generated to cover a subset of the digital document such that the remaining document can be concurrently viewed (Figs. 2A-2B, 3A-3B; *See Paragraph 0032, 0034-0035 and Figs. 2A-2B and 3A-3B wherein the user annotates the digital document by at least one of a manual and an automatic technique to enable rendering of new data on a trace, recording of a freeform digital ink annotation on an automatic trace, rendering of freeform digital ink annotations on automatic traces, viewing a portion of an automatic trace that corresponds to some or all of the freeform digital ink annotations at a user's request and managing the storage of the data trace based upon freeform digital ink annotations*).

Re Claims 5 and 19:

The claim 5 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the inking region magnifies the portion of the digital document within the inking region.

However, Price further discloses the claim limitation that the inking region magnifies the portion of the digital document within the inking region (*Figs. 3A-3B wherein the inking region in Fig. 3B is magnified/zoomed and Paragraph 0035 wherein the cited reference discloses scaling of the record along with the freeform digital ink annotations at the user's request*).

The claim 19 is subject to the same rationale of rejection set forth in the claim 5.

Claim 6:

The claim 6 encompasses the same scope of invention as that of the claim 5 except additional claim limitation that the magnification factor is defined such that the user inks at a similar size to document information.

However, Price further discloses the claim limitation that the magnification factor is defined such that the user inks at a similar size to document information (*Paragraph 0033 wherein the cited reference discloses the user may be provided with control over the scale of the display of the data trace so that the scale of the entire data trace may be adjusted so that the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital annotation and an embodiment may scale the freeform digital ink annotations in correspondence with the scaling of a display of the data trace in accordance with user preferences*).

Re Claims 7 and 16:

The claim 7 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein the inking region is closed via one of a digital pen, a mouse, a button and voice activation.

However, Price further discloses the claim limitation wherein the inking region is closed via one of a digital pen, a mouse, a button and voice activation (*Price discloses in Paragraph 0032 a pen is used to permit freeform digital ink annotations*).

The claim 16 is subject to the same rationale of rejection set forth in the claim 7.

Re Claims 8 and 15:

The claim 8 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein inking within the inking region scales down to a size similar to the text within the digital document when the inking region is closed.

However, Price further discloses the claim limitation wherein inking within the inking region scales down to a size similar to the text within the digital document when the inking region is closed (*Paragraph 0033 wherein the cited reference discloses the user may be provided with control over the scale of the display of the data trace so that the scale of the entire data trace may be adjusted so that the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital annotation and an embodiment may scale the freeform digital ink annotations in correspondence with the scaling of a display of the data trace in accordance with user preferences*).

The claim 15 is subject to the same rationale of rejection set forth in the claim 8.

Claim 9:

The claim 9 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein the navigation component employs one or more of a move inking region, a move digital document and a create space technique to navigate through the digital document.

However, Price further discloses the claim limitation wherein the navigation component employs one or more of a move inking region, a move digital document and a create space technique to navigate through the digital document (*Paragraph 0033 wherein the cited reference discloses the user may be provided with control over the scale of the display of the data trace so that the scale of the entire data trace may be adjusted so that the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital annotation and an embodiment may scale the freeform digital ink annotations in correspondence with the scaling of a display of the data trace in accordance with user preferences; Price discloses in Paragraph 0032 a pen is used to permit freeform digital ink annotations wherein the trace might extend from one edge to the other when the pen is moved*).

Re Claims 10-12:

The claim 10 encompasses the same scope of invention as that of the claim 9 except additional claim limitation the move inking region, move digital document and create space techniques are based on a space-scale framework.

However, Price further discloses the claim limitation the move inking region, move digital document and create space techniques are based on a space-scale framework (*Paragraph 0033 wherein the cited reference discloses the user may be provided with control over the scale of the display of the data trace so that the scale of the entire data trace may be adjusted so that*

the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital annotation and an embodiment may scale the freeform digital ink annotations in correspondence with the scaling of a display of the data trace in accordance with user preferences).

The claims 11-12 are subject to the same rationale of rejection set forth in the claim 10.

Re Claims 13 and 18:

The claim 13 encompasses the same scope of invention as that of the claim 1 except additional claim limitation an orientation of the inking region is determined via moving a digital pen across the document in one of a right-to-left, a left-to-right, a top-to-bottom, and a bottom-to-top manner.

However, Price further discloses the claim limitation an orientation of the inking region is determined via moving a digital pen across the document in one of a right-to-left, a left-to-right, a top-to-bottom, and a bottom-to-top manner (*Price discloses in Paragraph 0032 a pen is used to permit freeform digital ink annotations).*

The claim 18 is subject to the same rationale of rejection set forth in the claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al. US Patent Application Publication 2001/0043716 (hereinafter Price) in view of N. O. Bouvin et al., "Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards", **Proceedings of the 11th international conference on World Wide Web,** May 7-11, 2002, Honolulu, Hawaii, Pages 160-171 (hereinafter Bouvin).

Claim 3:

The claim 3 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document.

Price does not explicitly teach the claim limitation that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document. However, Price teaches in Figs. 2A-2B and 3A-3B that the inking region in Fig. 2B or 3B grows out of the digital document and thus Price at least suggests the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document.

However, Bouvin discloses the claim limitation that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document (See Fig. 2 in Page 162 wherein the smooth gloss animation associated with an annotation is displayed).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to have incorporated Bouvin's animation into Price's algorithm system because Price teaches in Figs. 2A-2B and 3A-3B that the inking region in Fig. 2B or 3B grows out of the

digital document and thus Price at least suggests the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document.

One of the ordinary skill in the art would have been motivated to provide the smooth gloss animation for the annotated portion or passage of the document (See Bouvin Fig. 2 in Page 162).

The claim 17 is subject to the same rationale of rejection set forth in the claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. U.S. Patent Application Publication 2003/0070139 (hereinafter Marshall) in view of Nagae U.S. Patent No. 6,230,169 (hereinafter Nagae).

Re Claims 1, 14 and 20:

Marshall discloses a system that facilitates free form digital inking (e.g., Figs. 2-6), the system is recorded on a computer-readable medium and capable of execution by a computer, comprising:

An annotation management component (Figs. 7-10) that generates an inking region for a digital document (See Figs. 2-6 wherein at least an inking region is generated and zoomed); and

A navigation component (Figs. 7-10) that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document (*The user annotates the document to produce annotations such as the high-value annotations associated with the asterisk icons 510, 520 and 530 and the size and shape of the inking region dynamically depend upon the annotations highlighted/encircled/underlined by the emphasis determination circuit or routine while the user annotates the digital document; see Paragraph 0065 and 0074 for the annotation types including highlighting, encircling and underlining by the ink strokes over the annotated document. See Fig. 6 and Paragraph 0055 for the inking region wherein the inking region is stored in a memory and is displayed by a call-up 540 associated with the annotation associated with the asterisk 530 in an expanded view while maintaining the reader's orientation of the document 500. It is noted that the size of shape of the call-up associated with other annotations are dynamically dependent on the size and shape of the portions or passages of the document that have been annotated with the annotations, e.g., the annotations associated with the asterisk icon 510 and the asterisk icon 520*).

Marshall does not explicitly teach an annotation window in his system for freeform annotation using digital inking.

Nagae teaches the annotation window. Moreover, Nagae discloses a system that facilitates free form digital inking (e.g., Figs. 12, 13, 16A-16B, 17A-17C and 18), comprising:

An annotation management component that generates an inking region for a digital document (*Figs. 12, 13, 16A-16B, 17A-17C and 18 wherein the inking region is generated for*

the digital document; see column 7, lines 1-22 wherein Nagae discloses that the user adjusts the annotation window with a pen wherein the window can be enlarged or reduced. Moreover, the annotation image magnification change section reduces or enlarges the annotation display image of the annotation input window on which the annotation has been written and creates an annotation display image with the changed magnification); and

A navigation component that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document (*See Figs. 17A-17D wherein the inking region is dynamically adjusted while a user annotates the digital document; see column 8, lines 40-45 wherein Nagae discloses annotating the digital document by a total number of N annotations similar to the annotations displayed in Figs. 17a-17D; Figs. 12, 13, 16A-16B, 17A-17C and 18 wherein the inking region is generated for the digital document; see column 7, lines 1-22 wherein Nagae discloses that the user adjusts the annotation window with a pen wherein the window can be enlarged or reduced. Moreover, the annotation image magnification change section reduces or enlarges the annotation display image of the annotation input window on which the annotation has been written and creates an annotation display image with the changed magnification*).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to have incorporated Nagae's annotation window into Marshall's system because such annotation window, if incorporated into Marshall annotation system, allows the inking region to be enlarged or reduced dynamically by the user through the pen or cursor. One of the ordinary skill in the art would have been motivated to do so to allow the annotations to be made on the

inking region on the annotation window as taught by Nagae in Figs. 17a-17D (See also Nagae Figs. 11-12 and column 12, lines 20-32).

Claim 2:

The claim 2 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the annotation management component is invoked to generate the inking region by identifying a point of interest on the digital document by at least one of a manual and an automatic technique. However, Marshall further discloses the claim limitation that the annotation management component is invoked to generate the inking region by identifying a point of interest on the digital document by at least one of a manual and an automatic technique (See Figs. 2-6 of Marshall wherein the annotation can be made on the digital document by highlighting/underlining etc. the portions or passages of the digital document and the inking region are correspondingly generated by identifying a point of interest such as identifying a call-up 540 on the asterisk 530 to display an expanded view of the third high-value annotation).

Claim 4:

The claim 4 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the inking region is generated to cover a subset of the digital document such that the remaining document can be concurrently viewed.

However, Marshall further discloses the claim limitation that the inking region is generated to cover a subset of the digital document such that the remaining document can be concurrently viewed (Fig. 6).

Re Claims 5 and 19:

The claim 5 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the inking region magnifies the portion of the digital document within the inking region.

However, Marshall further discloses the claim limitation that the inking region magnifies the portion of the digital document within the inking region (Fig. 6 wherein the expanded view in the region 540 magnifies the portion or passage of the digital document within the inking region).

The claim 19 is subject to the same rationale of rejection set forth in the claim 5.

Claim 6:

The claim 6 encompasses the same scope of invention as that of the claim 5 except additional claim limitation that the magnification factor is defined such that the user inks at a similar size to document information.

However, Marshall further discloses the claim limitation that the magnification factor is defined such that the user inks at a similar size to document information (Fig. 6 clearly shows the claim limitation in the ink region 540).

Re Claims 7 and 16:

The claim 7 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein the inking region is closed via one of a digital pen, a mouse, a button and voice activation.

However, Marshall and Nagae further discloses the claim limitation wherein the inking region is closed via one of a digital pen, a mouse, a button and voice activation (*Marshall Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30 disclosing the close down is taught by the prior art; Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed wherein Nagae inherently teaches erasing/closing the window through the graphical user interface using a mouse*).

The claim 16 is subject to the same rationale of rejection set forth in the claim 7.

Re Claims 8 and 15:

The claim 8 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein inking within the inking region scales down to a size similar to the text within the digital document when the inking region is closed.

However, Marshall and Nagae further discloses the claim limitation wherein inking within the inking region scales down to a size similar to the text within the digital document when the inking region is closed (*Marshall Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30 disclosing the close down is taught by the prior art; Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein*

the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed wherein Nagae inherently teaches erasing/closing the window through the graphical user interface using a mouse).

The claim 15 is subject to the same rationale of rejection set forth in the claim 8.

Claim 9:

The claim 9 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein the navigation component employs one or more of a move inking region, a move digital document and a create space technique to navigate through the digital document.

However, Marshall and Nagae further discloses the claim limitation wherein the navigation component employs one or more of a move inking region, a move digital document and a create space technique to navigate through the digital document (Marshall Fig. 6 employs the move inking region. Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30. *Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed*).

Re Claims 10-12:

The claim 10 encompasses the same scope of invention as that of the claim 9 except additional claim limitation the move inking region, move digital document and create space techniques are based on a space-scale framework.

However, Marshall and Nagae further discloses the claim limitation the move inking region, move digital document and create space techniques are based on a space-scale framework (Marshall Fig. 6 employs the move inking region. Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30. *Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed*).

The claims 11-12 are subject to the same rationale of rejection set forth in the claim 10.

Re Claims 13 and 18:

The claim 13 encompasses the same scope of invention as that of the claim 1 except additional claim limitation an orientation of the inking region is determined via moving a digital pen across the document in one of a right-to-left, a left-to-right, a top-to-bottom, and a bottom-to-top manner.

However, Marshall and Nagae further discloses the claim limitation an orientation of the inking region is determined via moving a digital pen across the document in one of a right-to-left, a left-to-right, a top-to-bottom, and a bottom-to-top manner (Marshall Fig. 6 and Paragraph 0064 employs the move inking region by moving the pen. Paragraph 0041, 0066 disclosing the

fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1-2).

The claim 18 is subject to the same rationale of rejection set forth in the claim 13.

Claim 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. U.S. Patent Application Publication 2003/0070139 (hereinafter Marshall) in view of Nagae U.S. Patent No. 6,230,169 (hereinafter Nagae) and N. O. Bouvin et al., "Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards", **Proceedings of the 11th international conference on World Wide Web,** May 7-11, 2002, Honolulu, Hawaii, Pages 160-171 (hereinafter Bouvin).

Claim 3:

The claim 3 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document.

Marshall and Nagae are silent to the claim limitation that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document.

However, Bouvin discloses the claim limitation that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document (See Fig. 2 in Page 162 wherein the smooth gloss animation associated with an annotation is displayed).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to have incorporated Bouvin's animation into Marshall and Nagae's system because Marshall has taught the embedded expanded view of the annotated portions of the digital document and such expanded view may be animated using the smooth gloss animation of Bouvin.

One of the ordinary skill in the art would have been motivated to provide the smooth gloss animation for the annotated portion or passage of the document (See Bouvin Fig. 2 in Page 162).

The claim 17 is subject to the same rationale of rejection set forth in the claim 3.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jin-Cheng Wang whose telephone number is (571) 272-7665. The examiner can normally be reached on 8:00 - 6:30 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jcw